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09/769,906	01/25/2001	Matthew Bruce Tropper		5001

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Matthew B. Tropper
30 Southern Parkway
Plainview, NY 11803

EXAMINER
PHAM, HUNG Q

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,906	Applicant(s) TROPPER, MATTHEW BRUCE	
	Examiner HUNG Q PHAM	Art Unit 2172	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4 and 16-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4 and 16-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

1.   Applicant amended claims 1-2 and 4, canceled claims 3 and 5-15, and

added claimed 16-22. The pending claims are 1-2, 4 and 16-22. Claims 1-2 and 4 have

been reconsidered by examiner, however, the claims still could not be defined over the

Rivette reference as the following action. In addition, the claim for domestic priority

under 35 U.S.C 119 (e) (to a provisional application) is acknowledged.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1-2, 4 and 16-22 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Rivette et al. [USP 6,339,767 B1].

Regarding to claim 1, Rivette teaches a method of maintaining databases of

patents. As shown in Fig. 6 is the databases 316, which store patent information, and

information pertinent to the analysis of the document information (Col. 17, line 16-Col.

23, line 25). As shown in Fig. 86, the patent citation module 1004 operates to identify,

for a particular source patent as *a patent under test*, the patents which were cited during

the prosecution of the selected patent are called citing patents. In step 8606, the patent

citation module 1004 receives information from the requesting client 304, 306 that

identifies one or more BOM groups. BOM group database is a group that contains

patents that map to a product, or parts of a product. In step 8608, the patent citation

module 1004 identifies the patents, which are mapped to the BOM groups

corresponding to the BOM_ids identified in step 8606. In step 8610, the patent citation

module 1004 identifies the patents that are cited in the patents identified in step 8608 by

reference to the PatentRef table 1208. In step 8610, the patent citation module 1004

forwards the results to the requesting client 304, 306 (Col. 87, lines 4-58; Col. 21, line

64-Col. 22, line 4). As seen, the database 316 is search by using PatentRef table to

identify and store in a result list the cited patents of a particular source patent. In other

words, this technique performs the claimed *searching the database and storing as first*

generation data identifying data corresponding to at least one patent in the database which is

cited in the patent under test. Rivette does not explicitly teach the step of *searching the*

database and storing as second generation data identifying data corresponding to at least one

patent in the database which is cited in at least one patent identified by the first generation

data; and operating on the second generation data to identify or filter out at least one patent

identified in the second generation data that is cited in the patent under test. However, as

disclosed by Rivette at step 8612 in Fig. 86, the patent citation report can be performed

and displayed in a recursive fashion with an operator specified depth. As shown in Fig.

65 is the display of a recursive patent citation function. In Fig. 65, patent 1 is the source

patent, and patents 2-4 are cited in patent 1. The patent citation report of Fig. 65 is

multi-leveled. Accordingly, the display format of Fig. 65 indicates that patents 5-8 are

cited in patent 2, patent 9 is cited in patent 3, and patents 10-12 are cited in patent 4.

The format 6502 as in Fig. 65 is a two level patent citation report and can be any

operator specified level. Other display formats could be used by the invention to more

effectively display the results of multi-level patent citation reports, such as the well-

known Xerox hyperbolic tree display format. The patent citation module 1004 collects

data for a multi-level patent citation report by repetitively performing the steps of

flowchart 8602 (Col. 88, line 65-Col. 89, line 21). As seen, by specifying a level at step

8612, the database 316.is searched again to identify and store citing patents

corresponding to the cited patents of the result of step 8610 in a tree displaying format,

or in other words, *searching the database and storing as second generation data identifying*

data corresponding to at least one patent in the database which is cited in at least one patent

identified by the first generation data, and the Xerox hyperbolic tree displaying of the

recursive patent citation function as shown in Fig. 65 indicates the step of *operating on*

the second generation data to identify or filter out at least one patent identified in the second

generation data that is cited in the patent under test. Therefore, it would have been obvious

for one of ordinary skill in the art at the time the invention was made to modify the

Rivette method by including the step of searching the database and storing as second

generation data, operating on second generation data to identify patents in order to

retrieve the cited patents in a particular source patent.

Regarding to claim 2, Rivette teaches all the claimed subject matters as

discussed in claim 1, and further discloses the step of *receiving from a user an*

identification of the patent under test (Fig. 89).

Regarding to claim 4, Rivette teaches all the claimed subject matters as

discussed in claim 1, and further discloses the step of *displaying at least the operated-on*

second generation data to a user (Fig. 65).

Regarding to claim 16, Rivette teaches all the claimed subject matters as

discussed in claim 4, and further discloses the step of *displaying both the operated-on*

second generation data and the first generation data to the user (Col. 87, line 59-Col. 89,

line 21).

Regarding to claim 17, Rivette teaches all the claimed subject matters as

discussed in claim 1, and further discloses one of the steps *(a) storing as first generation*

data identifying data corresponding to each patent in the database which is cited in the patent

under test; (b) storing as second generation data identifying data corresponding to each patent

in the database which is cited in each patent identified by the first generation data; and (c)

operating on the second generation data to identify or filter out each patent identified in the

second generation data that is cited in the patent under test (Fig. 86, Col. 87, lines 4-58).

Regarding to claim 18, Rivette teaches a method of maintaining databases of

patents. As shown in Fig. 6 is the databases 316, which store patent information, and

information pertinent to the analysis of the document information (Col. 17, line 16-Col.

23, line 25). As shown in Fig. 86, the patent citation module 1004 operates to identify,

for a particular source patent as *a patent under test*, the patents which were cited during

the prosecution of the selected patent are called citing patents. In step 8606, the patent

citation module 1004 receives information from the requesting client 304, 306 that

identifies one or more BOM groups. BOM group database is a group that contains

patents that map to a product, or parts of a product. In step 8608, the patent citation

module 1004 identifies the patents, which are mapped to the BOM groups

corresponding to the BOM_ids identified in step 8606. In step 8610, the patent citation

module 1004 identifies the patents that are cited in the patents identified in step 8608 by

reference to the PatentRef table 1208. In step 8610, the patent citation module 1004

forwards the results to the requesting client 304, 306 (Col. 87, lines 4-58; Col. 21, line

64-Col. 22, line 4). As seen, the database 316 is search by using PatentRef table to

identify and store in a result list the cited patents of a particular source patent. In other

words, this technique performs the claimed *searching the database and storing as first*

generation data identifying data corresponding to at least one patent in the database which is

cited in the patent under test. Rivette does not explicitly teach the step of *searching the*

database and storing as second generation data identifying data corresponding to at least one

patent in the database which cites at least one patent identified by the first generation data;

and operating on the second generation data to identify or filter out at least one patent

identified in the second generation data that is cited in the patent under test. However, as

disclosed by Rivette, the patent citation module 1004 also performs a forward citation

function by identifying, for a source patent, the patents in which the source patent was

cited (Col. 87, lines 10-15). As shown in step 8708 of Fig. 87, the patent citation module

1004 identifies the patents by conducting a search in the BOM_patent_xref table 1218

using the BOM_ids. In step 8710, the patent citation module 1004 determines the

patents that cite the patents identified in step 8708. The patent citation module 1004

forwards the results of the above operation to the client analysis module 716 in the

requesting client 304, 306. In step 8712, the client analysis module 716 displays this

information received from the patent citation module 1004 on the client display monitor

1122. The client analysis module 716 displays this information to the operator in any

one of a number of display formats as shown in Fig. 61-65 (Col. 89, lines 22-53). As

seen, instead of using the identified patents of step 8708, the identified patents result of

backward search in step 8610 could be used to determine the patents that cite these

identified patents to perform the claimed *searching the database and storing as second*

generation data identifying data corresponding to at least one patent in the database which

cites at least one patent identified by the first generation data. The result then is forwarded

to the client for displaying in a particular format as in Fig. 61-65 of step 8712 as

operating on the second generation data to identify or filter out at least one patent identified in

the second generation data that is cited in the patent under test. Therefore, it would have

been obvious for one of ordinary skill in the art at the time the invention was made to

modify the Rivette method by including the step of searching the database and storing

as second generation data, operating on second generation data to identify patents in

order to retrieve the citing patents of the cited patents in a particular source patent.

Regarding to claim 19, Rivette teaches all the claimed subject matters as

discussed in claim 18, and further discloses the step of *receiving from a user an*

identification of the patent under test (Fig. 89).

Regarding to claim 20, Rivette teaches all the claimed subject matters as

discussed in claim 18, and further discloses the step of *displaying at least the operated-on*

second generation data to a user (Fig. 65).

Regarding to claim 21, Rivette teaches all the claimed subject matters as

discussed in claim 20, and further discloses the step of *displaying both the operated-on*

second generation data and the first generation data to the user (Col. 87, line 59-Col. 89,

line 21).

Regarding to claim 22, Rivette teaches all the claimed subject matters as

discussed in claim 18, and further discloses one of the steps *(a) storing as first*

generation data identifying data corresponding to each patent in the database which is cited in

the patent under test; (b) storing as second generation data identifying data corresponding to

each patent in the database which is cited in each patent identified by the first generation data;

and (c) operating on the second generation data to identify or filter out each patent identified

in the second generation data that is cited in the patent under test (Fig. 86, Col. 87, lines 4-

58).

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

5.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to HUNG Q PHAM whose telephone number is 703-

605-4242. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, KIM Y VU can be reached on 703-305-4393. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

Hung Pham
August 14, 2003

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER